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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/498,944	02/04/2000	Christopher Warnock	EBRA.001USI	9493
21971	7590	02/17/2005	EXAMINER	
WILSON SONSINI GOODRICH & ROSATI 650 PAGE MILL ROAD PALO ALTO, CA 943041050			LE, NANCY LOAN T	
			ART UNIT	PAPER NUMBER
			3621	
DATE MAILED: 02/17/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/498,944	WARNOCK ET AL.	
	Examiner	Art Unit	
	NANCY LOAN T. LE	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 15, 17-21 and 55-85 is/are pending in the application.
- 4a) Of the above claim(s) 27-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 15, 20, 21, 55-61 and 66-85 is/are rejected.
- 7) ☒ Claim(s) 17-19 and 62-65 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/19/04 & 10/25/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of claims 1-26 in the reply filed on June 22, 2004 is acknowledged.

Claims 27-54 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected claims, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on June 22, 2004.

The requirement is still deemed proper and is therefore made FINAL.

Status of Claims

The amendment filed on July 6, 2004 has been received and entered. Claims 4-14, 16, 22-26 were cancelled; claims 1-3, 15, 17-18, 20-21 were amended; claim 19 remains the same; claims 55-85 were added. Therefore, claims 1-3, 15, 17-21, 55-85 are now pending, and have been examined.

Priority

Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(e) of provision application 60/159,737 filed on October 15, 1999.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on April 19, and October 25 of 2004 was filed after the mailing date of the non-provisional application no. 09/498,944 filed on February 4, 2000. The submission is in compliance with the provisions of 37 CFR 1.97 for all of the references cited by applicant except one foreign non-patent literature publication of January 1998 (1998-01), pages 1-68, XP002229195 Trento, Italy (reason: a copy of this foreign NPL is

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not included). Accordingly, the information disclosure statement, excluding the afore-mentioned foreign NPL, is being considered by the examiner.

Claim Objections

1. Claim 20 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim, claim 19. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 76 is objected to because of the following informalities: a duplicate of claim 73 (i.e., the claim language and logic repeat itself). Likewise objected to claim 77: a duplicate of claim 74. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to further limit the invention. The claim language and logic repeat itself.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-3, 15, 21, 55-61, 66-85 are rejected under 35 U.S.C. 102(b) as being anticipated by Sprague et al., U.S. Patent No. 5,247,575, 9/21/1993.

As per claim 1, Sprague et al. disclose a method for allowing a user to access document content using a logic device comprising:

- providing a user a first viewable version of contents of documents residing at a server on a first cost basis, said first viewable version being protected to prevent the user from performing standard operations on said version such as copying, printing or saving (col. 3, lines 46-52; col. 4, lines 44-51; col. 6, lines 63-66);
- calculating a charge to permit the user to perform a requested action on a user-selected portion of document content on a second cost basis (col. 4, lines 8-43, 60-68);
- providing a second version of the user-selected portion on which a user requested action is completed upon payment of the calculated charge (col. 3, lines 65-68; col. 4, lines 1-22, 61-66).

As per claims 2 and 68, Sprague et al. disclose a method recited in claims 1 and 67, respectively, wherein calculating the charge further comprises:

- calculating the charge on the basis of the granularity of the user-selected portion including whole and partial pages (col. 4, lines 8-12, 38-40).

As per claims 3 and 69, Sprague et al. disclose a method recited in claims {1 or 2}, and 67, respectively, wherein calculating the charge further comprises:

- calculating the charge based in part on the action requested (col. 4, lines 16-27).

As per claim 15, Sprague et al. disclose a method recited in claim 1 wherein calculating the charge further comprises:

- calculating said charge in part on a network address from which said user accesses said server (col. 5, lines 9-16; col. 6, lines 25-45).

As per claim 21, Sprague et al. disclose a method recited in claim 1 wherein the user-selected portion may include an anthology from multiple documents (col. 4, lines 44-56).

As per claim 55, Sprague et al. disclose a method recited in claim 1 or 2, wherein providing the first viewable version further comprises:

- providing document contents to the user in an encrypted format (col. 6, lines 58-62).

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As per claim 56, Sprague et al. disclose a method recited in claim 55 further comprising:

- using client-side software for permitting the user to view the encrypted format of the first version (col. 6, lines 58-62).

As per claim 57, Sprague et al. disclose a method recited in claim 1 or 2, wherein providing the first viewable version further comprises:

- providing document content at a resolution sufficient for viewing but not for satisfactory completion of the requested action (col. 3, lines 46-52; col. 4, lines 44-51; col. 6, lines 63-66).

As per claim 58, Sprague et al. disclose a method recited in claim 57 wherein providing the second version further comprises:

- providing document content in a higher resolution on which satisfactory completion of the requested action may be performed (col. 6, lines 67-68; col. 7, lines 1-3).

As per claim 59, Sprague et al. disclose a method recited in claim 57 wherein providing the second version further comprises:

- providing document content in a form not directly accessible by the user (col. 6, lines 58-66).

As per claim 60, Sprague et al. disclose a method recited in claim 1 or 2, wherein providing the first version further comprises:

- providing document content in a form viewable by the user only upon authorization from a third party (col. 6, lines 25-46).

As per claim 61, Sprague et al. disclose a method recited in claim 60 wherein providing document content in a form viewable by the user only upon authorization from a third party further comprises:

- providing authorization for viewing by the user only as the document content is being provided from the server (col. 6, lines 25-46).

As per claim 66, Sprague et al. disclose a method recited in claim 65 wherein calculating the charge further comprises:

- calculating the charge on the bases of the user-selected portion including text and on the basis of the user selected portion including graphics (col. 4, lines 8-12).

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As per claim 67, Sprague et al. disclose a method for allowing the purchase of information from a server, comprising:

- serving user-requested pages of information from a server in a protected form permitting viewing and selecting by a user but not printing, copying or saving by the user (col. 3, lines 46-52; col. 4, lines 44-51; col. 6, lines 63-66);
- calculating a charge to permit a requested action to be performed on a user-selected portion of the information served (col. 4, lines 8-43, 60-68); and
- providing the user-selected portion, upon authorization of payment of the calculated charge in a second form on which the requested action is performed (col. 3, lines 65-68; col. 4, lines 1-22, 61-66).

As per claim 70, Sprague et al. disclose a method recited in claim 67 or 68 wherein serving the user-requested pages of information further comprises:

- serving low-resolution images of full pages of information (col. 3, lines 46-52; col. 4, lines 44-51; col. 6, lines 63-66).

As per claim 71, Sprague et al. disclose a method recited in claim 70 wherein providing the user-selected portion further comprises:

- providing text within the user-selected portion of the low-resolution images in the form of text on which the action may be performed (col. 3, lines 46-52; col. 4, lines 44-51; col. 6, lines 63-66).

As per claim 72, Sprague et al. disclose a method recited in claim 71 wherein providing the user-selected portion further comprises:

- providing images within the user-selected portion of the low-resolution images in the form of high-resolution images on which the action may be performed upon authorization of the charges (col. 6, lines 67-68; col. 7, lines 1-3).

As per claims 73 and 76, Sprague et al. disclose a method recited in claim 67, 68, or 69, further comprising:

- encrypting the serving user-requested pages of information before serving them to the user (col. 6, lines 58-66); and

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- requiring authorization from a third party before permitting viewing and selecting of user-requested pages by the user (col. 6, lines 25-46).

As per claims 74 and 77, Sprague et al. disclose a method recited in claim 73 and 76 respectively, further comprising:

- encrypting the user-selected portion before providing the user-selected portion to the user (col. 6, lines 58-66); and
- requiring authorization from the third party before the requested action may be performed (col. 6, lines 25-46).

As per claim 75, Sprague et al. disclose a method recited in claim 71 wherein providing the user-selected portion further comprises:

- providing images within the user-selected portion of the low-resolution images in the form of high-resolution images on which the action may be performed upon authorization of the charges (col. 6, lines 67-68; col. 7, lines 1-3).

As per claim 78, Sprague et al. disclose a method recited in claim 67, 68, or 69, wherein serving the user-requested pages further comprises:

- serving the user-requested pages of information in a low-resolution format sufficient for permitting viewing and selecting by a user but not sufficient for acceptable printing, copying or saving by the user (col. 3, lines 46-52; col. 4, lines 44-51; col. 6, lines 63-66).

As per claim 79, Sprague et al. disclose a method recited in claim 78 wherein providing the user-selected portion further comprises:

- providing the user-requested portion in a high-resolution format sufficient for acceptable printing, copying and/or saving by the user (col. 6, lines 67-68; col. 7, lines 1-3).

As per claims 80, 82, and 84, Sprague et al. disclose a method recited in claim 67, 68, or 69, wherein serving user-requested pages of information further comprises:

- serving user-requested text and/or images in the form of low-resolution images of pages of text suitable for viewing and selecting (col. 3, lines 46-52; col. 4, lines 44-51; col. 6, lines 63-66).

As per claim 81, Sprague et al. disclose a method recited in claim 80, wherein providing the user-selected portion further comprises:

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- providing user-selected text suitable for performing the requested action is performed (col. 6, lines 67-68; col. 7, lines 1-3).

As per claim 83, Sprague et al. disclose a method recited in claim 80, wherein providing the user-selected portion further comprises:

- providing user-selected images in the form of high-resolution images suitable for performing the requested action (col. 6, lines 67-68; col. 7, lines 1-3).

As per claim 85, Sprague et al. disclose a method recited in claim 84, wherein providing the user-selected portion further comprises:

- providing the user-selected text in the form of text suitable for the requested action (col. 6, lines 67-68; col. 7, lines 1-3); and
- providing images in the form of high-resolution images suitable for performing the requested action (col. 6, lines 67-68; col. 7, lines 1-3).

Allowable Subject Matter

4. Claims 17-19, 62-65 are objected to as being dependent upon a corresponding rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Data processing system and method to enforce payment of royalties when copying softcopy books, Hartrick et al., U.S. Patent No. 5,532,920, 7/2/1996.
- Regulating access to digital content, Patterson, U.S. Patent No. 6,389,541, 5/14/2002.
- Kiosk apparatus and method for point of preview and for compilation of market data, Kaplan, U.S. Patent No. 5,237,157, 8/17/1993.
- Stored program pay-per-play, Russo, U.S. Patent No., 5,619,247, 4/8/1997.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANCY LOAN T. LE whose telephone number is (703) 305-0549. The examiner can normally be reached on Monday-Friday, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES P. TRAMMELL can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306, for official/regular communication. For informal/draft communication, the fax number is 703-302-3376 (rightfax).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

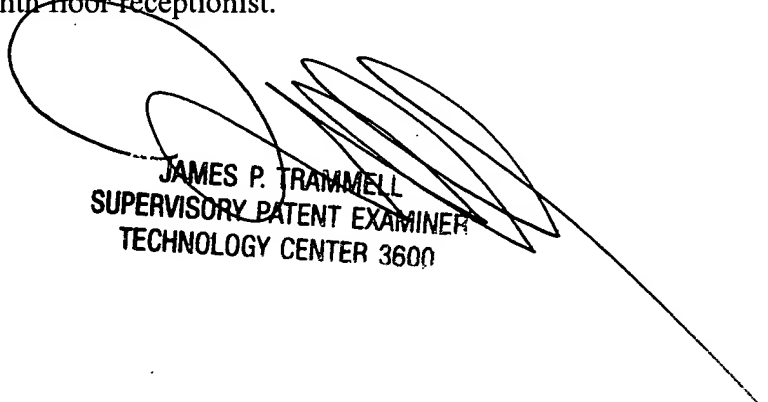
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, Virginia 22202, seventh floor receptionist.

NL
2/7/2005


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600